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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/682,647	10/08/2003	Jonathan D. Bloom	03127.000500.	8261
5514	7590	06/16/2006	EXAMINER VALENROD, YEVGENY	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			ART UNIT 1621	PAPER NUMBER

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/682,647

Applicant(s)

BLOOM ET AL.

Examiner

Yevgeny Valenrod

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,11-15,17 and 18 is/are rejected.
- 7) ☐ Claim(s) 2-10 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10-8-03; 10-26-04</u> . | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Rejections 35 USC 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 12, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Wright et al (J. Med. Chem. 2001 44 3187). On page 3188 column 2 structure 17, Wright teaches 2-[[N-(3-bromophenyl)glycyl]amino]benzoic acid and 2-[[N-(3,4-dichlorophenyl)glycyl]amino]benzoic acid which are found in the generic structure of claims 11, and 17 and is specifically listed in claim 12.

***Rejection 35 USC 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-14, 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bierer et al (US 5,741,926).

The instant application claims pharmaceutical compositions comprising compounds as described by formulas of independent claims 11 or 17, and their dependent claims 12-13 and 18.

*Scope of prior art*

Bierer et al. teach a general structure of Formula III that encompasses the compounds included in claims 11-14, 17 and 18 of the instant application.

*Ascertaining the difference between prior art and the instant application*

Although the structure of formula III taught by Bierer et al. encompasses the specific compounds of the instant application, it does not specifically list the same compounds as are recited in claims 12-13 and claim 18.

*Obviousness*

The generic structure of formula III teaches the instant claims with sufficient particularity that the compounds of the instant invention would have been prima facie obvious. The said particularity arises from structural similarities such as the 2-(((phenyl)amino)acetyl)aminobenzoic acid structural core and the optional multiple substitutions with various halogens which are present in the specific examples provided by Bierer et al (see column, 11 line 40 – column 12 line 16).

***Rejection 35 USC 103***

Claims 1 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryznerski et al (ACTA POLON PHARM XXXVIII, 1981, 5, p 534-537, particularly the abstract, see p 537) in view of Matsuda et al. (US 5,637,597).

In claims 1 and 5 of the instant application the applicant claims a method of treating Hepatitis C comprising administering the pharmaceutical composition comprising the a compound of a generic structure provided in the said claims.

*Scope of Prior Art*

Ryznerski et al. teach compounds of generic structure I-XVII (page 534) with anti-inflammatory properties (see abstract on page 537). The scope of the generic structure presented by Ryznerski et al overlaps the scope of the generic compounds found in the instant claims 1 and 15.

*Ascertaining the Difference between Prior Art and the Instant Application.*

Ryznerski et al teach the compounds and the anti-inflammatory properties of the compounds found in claims 1 and 15. They do not teach a method of treating hepatitis C comprising the administration of the compounds.

*Secondary reference*

Matsuda et al. teach that Hepatitis C is an inflammatory hepatic disease (column 6 lines 3-4).

*Obviousness*

The compounds of claims 1 and 15 are known to have anti-inflammatory properties, (Ryznerski et al.), and Hepatitis C is an inflammatory disease, (Matsuda et al). It is there fore obvious to a person of ordinary skill in the art that the compounds taught by Ryznerski can be used for treatment of Hepatitis C.

***Allowable Subject Matter***

Claims 2-10 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

**Conclusion**

Claims 1-18 are pending in the application.



Claims 1, 11-15 and 17-18 are rejected.

Claims 2-10 and 16 are objected to.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yevgeny Valenrod whose telephone number is 571-272-9049. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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